

## **In the United States Patent and Trademark Office**

Appellants:	John Patrick Costello et al.	Docket No.:	19,961
Serial No.:	10/813,873	Group:	1791
Confirmation No:	5578	Examiner:	Osele, Mark A
Filed:	March 31, 2004	Date:	January 20, 2010
For:	TWO-STEP REGISTERED PRINTING		

### **Brief on Appeal to the Board of Patent Appeals and Interferences**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.37 Appellants respectfully submit this Brief in support of their Appeal of Examiner Osele's **Final Rejection** of claims 14-21 which was mailed on August 20, 2009.

On November 20, 2009, Appellants, pursuant to 37 C.F.R. 41.31, faxed a timely Notice of Appeal which was received in the USPTO on November 20, 2009. Thus, this Brief is timely filed on January 20, 2010.

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#### **Real Party in Interest**

The present Application has been assigned to Kimberly-Clark Worldwide, Inc., which is the real party in interest.

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#### **Related Appeals and Interferences**

To the knowledge of Appellants, Appellants' legal representative, or assignee, there are no other known related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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**Status of Claims**

Claims 14-21 are currently pending in the application and have been finally rejected. The claims on appeal are identified as claims 14-21. Claims 1-13 and 22-24 were previously canceled. The appealed claims are recited in the Claims Appendix of this Brief.

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**Status of Amendments**

No amendments were filed subsequent to the Final Rejection mailed on August 20, 2009.

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**Summary of Claimed Subject Matter**

The following summary correlates claim elements to specific embodiments described in the application specification, but does not in any manner limit claim interpretation. Rather, the following summary is provided only to facilitate the Board's understanding.

The subject matter of independent claim 14 is directed to a method of printing an outer cover for an absorbent article. (See e.g., page 2, lines 21-23). The method includes: supplying a moving first substrate comprising a film to a first printing operation (see e.g., page 3, lines 18-20); contact printing at least one first graphic on the first moving substrate in the first printing operation using a gravure roll printer or flexographic printer (see e.g., page 3, lines 20-21); laminating a second moving substrate to the first moving substrate to form an outer cover, the second moving substrate has a nonwoven web and the outer cover defines a width (see e.g., page 3, lines 22-24); supplying the outer cover with the first graphic to a second printing operation on a manufacturing line for absorbent articles (see e.g., page 3, line 24 and page 8, lines 20-22); non-contact printing at least one second graphic on the outer cover in the second printing operation on the manufacturing line for absorbent articles using a wax jet printer, ink jet printer, bubble jet printer, or laser jet printer, the first graphic spanning at least 60% of the width of the outer cover and is visible to the naked eye, the second graphic being positioned within the center third of the width of the outer cover and being visible to the naked eye (see e.g., page 3, lines 24-29 and page 8, lines 20-22); and joining the outer cover with an absorbent and a liner to produce an absorbent article (see e.g., page 3, lines 29-30).

The subject matter of independent claim 18 is directed to a method of minimizing substrate printing waste (see e.g., page 4, line 4). The method includes: supplying a moving substrate to a first

converting operation (see e.g., page 4, line 5); printing a plurality of absence advertisements on the moving substrate using a contact printer (see e.g., page 4, lines 5-6); supplying the moving substrate with the absence advertisements to a second converting operation (see e.g., page 4, lines 6-7); and at least partially overprinting second graphics on at least some of the absence advertisements using a non-contact printer, where a failure to print a second graphic on an absence advertisement results in the absence advertisement remaining visible on the substrate (see e.g., page 4, lines 7-10).

The subject matter of independent claim 21 is directed to a method of printing an outer cover for an absorbent article. (See e.g., page 4, line 15). The method includes the steps of: laminating a first substrate comprising film to a second substrate comprising a nonwoven to form an outer cover, the outer cover defining a film side, a nonwoven side opposite the film side, and a width (see e.g., page 4, lines 15-18); supplying the outer cover to a printing process and contact printing at least one first graphic on the nonwoven side (see e.g., page 4, lines 18-19); supplying the outer cover to a converting operation, the converting operation combining the outer cover with an absorbent assembly to form an absorbent article (see e.g., page 4, lines 19-21); and non-contact printing has at least one second graphic on the nonwoven side in the converting operation, the first graphic spanning at least 60% of the width of the outer cover and being visible to the naked eye, the second graphic being positioned within the center third of the width of the outer cover, and both first and second graphics being visible to the naked eye (see e.g., page 4, lines 21-25).

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## **Grounds of Rejection to be Reviewed on Appeal**

### **Ground 1**

Claims 14-17 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,766,389 to Brandon et al. (hereinafter “Brandon”), in view of U.S. Patent No. 6,129,264 to Travers et al. (hereinafter “Travers”) or U.S. Patent No 5,906,156 to Shibuya et al. (hereinafter “Shibuya”), in further view of U.S. Patent No. 5,503,076 to Yeo (hereinafter “Yeo”), in still further view of U.S. Patent No. 6,732,778 to Machida et al. (hereinafter “Machida”) and in still further view of U.S. Patent No. 6,297,424 to Olson et al. (hereinafter “Olson”).

### **Ground 2**

Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandon in view of Travers or Shibuya, in further view of U.S. Patent Publication No 2005/0149389 to Odorzynski

(hereinafter “Odorzynski”) and in still further view of U.S. Patent No. 6,307,119 to Cammarota et al. (hereinafter “Cammarota”).

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## Argument

### **Ground 1 -- Rejection of Claims 14-17 and 21**

Claims 14-17 and 21 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Brandon, Travers, Shibuya, Yeo, Machida, and Olson.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The application of the “teaching, suggestion, or motivation” (TSM) test is not “rigid.” However, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness . . . .” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (emphasis added).

#### Claims 14-17 and 21

Appellants’ claims 14-17 require, *inter alia*, contact printing a first graphic on the film portion of an outer cover laminate in a first printing operation and then providing the outer cover with the first graphic to a manufacturing line for absorbent articles to non-contact print a second graphic on the outer cover.

Similarly, Appellants’ claim 21 requires, *inter alia*, contact printing a first graphic (first step) on the outer cover before presentation to the converting operation that forms absorbent articles. The non-contact printing (second step) on the outer cover occurs in the converting operation.

The prior art, alone or in combination, does not teach or suggest these claim limitations.

The Examiner rejected claims 14-17 and 21 over the combination of Brandon, Travers or Shibuya, Yeo, Machida and Olson. With regard to Brandon (i.e., the primary reference), the Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to use contact printing followed by non-contact printing in the method

of Brandon et al. because Travers et al. teaches that variable graphics are more easily changed using non-contact printing so the use of contact printing can print non-variable graphics while downstream non-contact printing can print variable graphics depending on the product being made....(Office Action dated August 20, 2009).

In response, Appellants respectfully note that claims 14-17 and 21 require that the outer cover, printed with the first graphic with contact printing, is provided to a manufacturing line or converting operation for assembling absorbent articles wherein the second graphic is printed on the outer cover using non-contact printing. In other words, the claim requires two-step printing wherein the contact printing (first step) on the outer cover occurs before presentation to the manufacturing line for absorbent article. The non-contact printing (second step) on the outer cover then occurs on the manufacturing line for absorbent article assembly. In contrast, as Appellants best understand it, the problem that Brandon is attempting to solve is the registration of two moving pre-printed substrates, which is different than the problem that the present invention solves (see e.g., Brandon col. 1, lines 61-65).<sup>1</sup> More particularly, Brandon discloses two moving substrates that are pre-printed to form a layer, prior to entering a manufacturing operation for assembling an absorbent article (see e.g., Brandon col. 12, lines 1-31). Brandon does not appear to teach or suggest two-step printing where printing on the outer cover via contact printing (i.e., the first step) occurs before presentation to the article assembly operation for absorbent articles, and printing on the outer cover via non-contact printing (i.e., the second step) occurs during the manufacturing assembly operation of absorbent articles. Thus, Brandon teaches away from the present invention.

The Examiner alleges that Travers and Shibuya disclose that variable graphics are more easily changed using non-contact printing so that the use of contact printing can print non-variable graphics while downstream non-contact printing can print variable graphics, and that non-contact printing devices can allegedly be easily added to manufacturing lines already using a contact printing device (Office Action dated August 20, 2009, page 3). However, the addition of Travers and Shibuya do not remedy the deficiencies of the primary reference (i.e., Brandon). Furthermore, both Travers and Shibuya are directed to printing on paper substrates, rather than polymeric nonwoven substrates in a manufacturing

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<sup>1</sup> The present invention solves the general problem of printing high quality images on an outer cover at speeds of 100 feet/minute or greater that is cost effective and minimizes waste associated with printing failures (Specification page 1 line 34 – page 2 line 18).

operation for absorbent articles. Therefore, the results of combining Travers and Shibuya with Brandon would be unpredictable.

The Examiner also combines Machida to allegedly teach that printing on a disposable absorbent article is conventionally performed in-line at a mid-portion of a manufacturing line (Office Action dated August 20, 2009, page 4). In response, as Appellants best understand it, Machida is directed to a single printing step. Machida does not teach or suggest two-step printing where printing on the outer cover via contact printing (i.e., the first step) occurs before presentation to the article assembly operation for absorbent articles, and printing on the outer cover via non-contact printing (i.e., the second step) occurs during the manufacturing assembly operation of absorbent articles. Thus, Machida teaches away from the present invention, and does not remedy the deficiencies of the primary reference. In addition, Machida also teaches away from Brandon (the primary reference) since Brandon (as discussed above) appears to require two moving substrates that are pre-printed prior to entering any converting operation. Thus, Machida cannot be combined with Brandon. Furthermore, even if *arguendo*, Machida could be combined with Brandon, the results would be unpredictable.

The Examiner also combines (with the primary reference) Yeo to allegedly teach a laminated substrate comprising a film layer and a nonwoven layer, as well as Olson to allegedly teach a first graphic spanning at least 60% of the width of the outer cover and second graphic positioned within the center third of the width of the outer cover. However, the addition of Yeo and Olson does not remedy the deficiencies of Brandon, Travers, Shibuya and Machida.

In addition to the problems with the cited references discussed above, it is quite clear that the Examiner is utilizing ***impermissible hindsight***. The Court in KSR held that a factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning (KSR, 127 S.Ct., at 1742). It seems clear that the Examiner is utilizing the teachings of Appellants in an attempt to modify Brandon with Travers, Shibuya, Yeo, Machida and Olson to allegedly arrive at Appellants' invention. Appellants respectfully note that MPEP §§ 2142 and 2143 require that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure. *In re Vaeck*, 947 F.2d 4899 (Fed. Cir. 1991). The mere fact that the prior art may be modified in the manner suggested by the Office does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. *In re Fritch*, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992). It is impermissible to use the claimed invention as an instruction manual or

"template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 Fed. 2d 982, 987, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991). *In re Fritch*, 23 USPQ 2d 1780 at 1784 (Fed. Cir. 1992).

In addition, the Court in *KSR* held that a patent composed of several elements is not proved obvious merely by demonstrating that each of the elements was, independently, known in the prior art, which is exactly what the Examiner has done here with respect to the present invention (*KSR*, 127 S.Ct., at 1741). The Court further emphasized the importance of **identifying a reason** that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does, which the Examiner has not provided, particularly since Brandon teaches away from the present invention, and Muchida teaches away from Brandon (*Id.*, emphasis added). Thus, any suggestion by the Examiner to modify Brandon with Travers, Shibuya, Yeo, Machida and Olson based on the knowledge gained from Appellants is improper.

It is respectfully noted that the Examiner may state that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Appellants' disclosure. However, as discussed above, the Examiner has not shown that Appellants' claimed invention was within the level of ordinary skill at the time the claimed invention was made based on the references cited by the Examiner (i.e., Brandon, Travers, Shibuya, Yeo, Machida and Olson), particularly since the references teach away.<sup>2</sup> For at least these reasons, the Examiner has improperly used hindsight in an attempt to arrive at Appellants' invention.

Lastly, the Examiner has combined no less than six references in an attempt to present a *prima facie* case of obviousness over the present invention. However, the Examiner has merely picked and chosen elements out of context from a plethora of references, but has not explained why an ordinary artisan would have considered it to be desirable to combine each reference as a whole, and has provided no guidance as to how an ordinary artisan could accomplish such a combination.

For at least these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claims 14-17 and 21. Appellants respectfully request that the Board reverse this rejection.

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<sup>2</sup> It is noted that the Examiner may cite *In re McLaughlin*, which is a 1971 CCPA ruling, as support for the law regarding the improper use of hindsight. However, Appellants respectfully note that *KSR v. Teleflex* is a 2007 U.S. Supreme Court ruling which is **precedential** over *In re McLaughlin*.

## **Ground 2 -- Rejection of Claims 18-20**

Claims 18-20 rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandon in view of Travers or Shibuya, Odorzynski and Cammarota.

### Claims 18-20

Arguments with respect to Brandon, Travers and Shibuya are discussed above.

In addition, Appellants' claim 18 requires, *inter alia*, an "absence advertisement." The Examiner cites Odorzynski and states that "any known advertising technique, including absence advertisements, would be envisioned by one of ordinary skill in the art from the disclosure of Odorzynski which teaches a wide array of advertising techniques and suggests that others are possible" (Office Action dated August 20, 2009, page 7). However, the Examiner has provided no evidence that the teaching of Odorzynski would extend to absence advertisements. Rather, Appellants respectfully submit that the Examiner's allegation is merely an incorrect opinion of the Examiner.

As Appellants best understand it, Odorzynski teaches the placement of advertising on baby diapers. These ads include detachable items, codes, and the like. However, Odorzynski does not teach or suggest "absence advertisements". As defined in Appellants' specification at the paragraph bridging pages 20 and 21, an "absence advertisement" is a graphic that conveys the message that an additional graphic is missing. Odorzynski does not teach or suggest advertisements that indicate that a graphic is missing. In addition, Appellants disclosed that an absence advertisement creates a "backup" system for printing which provides the unique advantage of eliminating product waste, and further provides the advantage of transforming potentially defective product into consumable product via a "game" (Specification page 20 line 34 – page 22 line 1).

The Examiner also combines Cammarota to allegedly teach a graphic overprinted on a graphic (Office Action dated August 20, 2009, page 8). However, the addition of Cammarota does not overcome the deficiencies of Brandon, Travers, Shibuya and Odorzynski.

For least these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claims 18-20. Appellants respectfully request that the Board reverse this rejection.



## Conclusion

For the reasons set forth in the above arguments, it is respectfully submitted that the rejections should be **reversed**. Accordingly, it is respectfully submitted that claims 14-21 are in allowable condition.

Please charge the \$540.00 fee (fee code 1402), pursuant to 37 C.F.R. 41.20(b)(2), for filing this Appeal Brief to Kimberly Clark Worldwide, Inc. deposit account number 11-0875. Any additional prosecutorial fees which are due may also be charged to deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account 11-0875.

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Respectfully submitted,

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K-C Docket No.: 19,961  
Serial No.: 10/813,873

**ELECTRONIC FILING CERTIFICATE**

I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the United States Patent and Trademark Office using the Electronic Filing System on January 20, 2010.

/Bryan R. Rosiejka/

Signature

Bryan R. Rosiejka

Typed Name

## Claims Appendix – Listing of the Claims On Appeal

The claims on appeal are:

**14.** A method of printing an outer cover for an absorbent article, comprising:

supplying a moving first substrate to a first printing operation, the first moving substrate comprising a film;

contact printing at least one first graphic on the first moving substrate in the first printing operation using a gravure roll printer or flexographic printer;

laminating a second moving substrate to the first moving substrate to form an outer cover, the second moving substrate comprising a nonwoven web and the outer cover defining a width;

supplying the outer cover with the first graphic to a second printing operation on a manufacturing line for absorbent articles;

non-contact printing at least one second graphic on the outer cover in the second printing operation on the manufacturing line for absorbent articles using a wax jet printer, ink jet printer, bubble jet printer, or laser jet printer, the first graphic spanning at least 60% of the width of the outer cover and being visible to the naked eye, the second graphic being positioned within the center third of the width of the outer cover and being visible to the naked eye; and

joining the outer cover with an absorbent and a liner to produce an absorbent article.

**15.** The method of claim **14**, wherein the absorbent article has a front waist region, a back waist region, and a crotch region connecting the front waist region and the back waist region, and the second graphic is positioned within the front waist region.

**16.** The method of claim **14**, wherein the absorbent article has a front waist region, a back waist region, and a crotch region connecting the front waist region and the back waist region, and the second graphic is positioned within the back waist region.

**17.** The method of claim **14**, wherein the absorbent article has a front waist region, a back waist region, and a crotch region connecting the front waist region and the back waist region, further comprising two or more second graphics, at least one second graphic positioned within the front waist region and at least one second graphic positioned within the back waist region.

**18.** A method of minimizing substrate printing waste, comprising:

supplying a moving substrate to a first converting operation;

printing a plurality of absence advertisements on the moving substrate using a contact printer;

supplying the moving substrate with the absence advertisements to a second converting operation;

at least partially overprinting second graphics on at least some of the absence advertisements using a non-contact printer, wherein a failure to print a second graphic on an absence advertisement results in the absence advertisement remaining visible on the substrate.

**19.** The method of claim **18**, further comprising joining the substrate to an absorbent and to a liner to form an absorbent article, the absence advertisement forming part of an interactive game or contest involving the user of the absorbent article.

**20.** The method of claim **18**, further comprising joining the substrate with an absorbent and a liner to form an absorbent article, the absence advertisement conveying contact information to a consumer of the absorbent article.

**21.** A method of printing an outer cover for an absorbent article, comprising:

laminating a first substrate comprising film to a second substrate comprising a nonwoven to form an outer cover, the outercovers defining a film side, a nonwoven side opposite the film side, and a width;

supplying the outer cover to a printing process and contact printing at least one first graphic on the nonwoven side,

supplying the outer cover to a converting operation, the converting operation combining the outer cover with an absorbent assembly to form an absorbent article;

non-contact printing at least one second graphic on the nonwoven side in the converting operation, the first graphic spanning at least 60% of the width of the outer cover and being visible to the naked eye, the second graphic being positioned within the center third of the width of the outer cover, and both first and second graphics being visible to the naked eye.

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**Evidence Appendix**

None

K-C Docket No.: 19,961  
Serial No.: 10/813,873

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**Related Proceedings Appendix**

None